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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,899	12/31/2001	Hideo Kijima	1384-01	1003
35811	7590	12/02/2004	EXAMINER	
IP DEPARTMENT OF PIPER RUDNICK LLP ONE LIBERTY PLACE, SUITE 4900 1650 MARKET ST PHILADELPHIA, PA 19103			JIMENEZ, MARC QUEMUEL	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/019,899	Applicant(s) KIJIMA ET AL.	
	Examiner Marc Jimenez	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan. It is noted, however, that no copies of the applications filed in Japan have been received from the International Bureau. The file that the examiner is working from does not have a copy of the Japan 2000-142914, 2000-142915, 2001-028788, 2001-028789, 2001-028790, 2001-028791 applications. Applicant is requested to submit copies of these documents in order to perfect foreign priority.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. **Claims 1 and 5/1** are rejected under 35 U.S.C. 102(a) as being anticipated by Yashihiro et al. (JP 2001-0471 12, see also translation cited in the PTO-892). See the paper mailed 6/28/04 for this rejection.

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5. **Claims 2 and 5/2** are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yashihiro et al. See the paper mailed 6/28/04 for this rejection.

6. **Claims 3, 4, 5/3, and 5/4** are rejected under 35 U.S.C. 102(a) as anticipated by Yashihiro et al. or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yashihiro et al. in view of Applicant's Admitted Prior Art (AAPA) (page 2, lines 13-14 of applicant's specification). See the paper mailed 6/28/04 for this rejection.

7. Applicant cannot rely upon the foreign priority papers to overcome these rejections because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15 for procedures in submitting translations of foreign papers. Furthermore, a copy of the foreign priority papers have not been received from the International Bureau.

8. **Claims 1 and 5/1** are rejected under 35 U.S.C. 102(b) as being anticipated by Sonobe et al. (EP 0 913 212 A1).

Sonobe et al. teach a cemented carbide roll having a sleeve 3 comprising a cemented carbide (for example, page 5, line 43) outer layer ("OUTER LAYER" in figure 9) formed integrally from a plurality of previously sintered (page 6, lines 34-36) cylindrical formed members 2 and an inner layer ("INTERMEDIATE LAYER" in figure 9) made of a steel member (see TABLE 2, "Inner layer of composite sleeve" made of "Mild steel") formed on the inner surface of the outer layer, fixed through engagement with a steel arbor ("SHAFT CORE" in

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figure 9), wherein the sleeve has a length within a range from 520 to 6,000 mm (see page 2, line 29).

Regarding claim 5, note the diameters (page 2, line 29).

Although the Sonobe et al. reference is considered to meet the forming methods, for example, “previously sintered”, note that the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). The final product claimed is considered the same as the structure in Sonobe et al.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 2 and 5/2** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonobe et al.

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Sonobe et al. do not specifically teach 5 to 30 formed members.

However, official notice is taken that it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have provided 5 to 30 formed members in order to form a sleeve having the desired length. Also, at the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used 5 to 30 formed members because applicant has not disclosed that 5 to 30 formed members provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the 2 formed members taught by Sonobe et al. or the claimed 5 to 30 formed members because either number of members perform the same function of providing a suitable working sleeve surface equally well.

11. **Claims 3, 4, 5/3, and 5/4** are rejected under 35 U.S.C. 102(a) as anticipated by

Sonobe et al. or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sonobe et al. in view of Applicant's Admitted Prior Art [AAPA] (page 2, lines 13-14 of applicant's specification).

Sonobe et al. inherently teach the claimed So/si ratio because Sonobe et al. teach using a cemented carbide as claimed. As stated in MPEP 21 12.01, "When the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent".

Alternatively, [AAPA] teaches using a ratio So/Si of from 0.3 to 20 (page 2, lines 13-14 of applicant's specification).

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Sonobe et al. with a ratio So/Si of from 0.3 to 20, in light of the teachings of [AAPA], in order to obtain the desired hardness of the formed members.

Regarding claim 4, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have made the prior art at the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

12. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

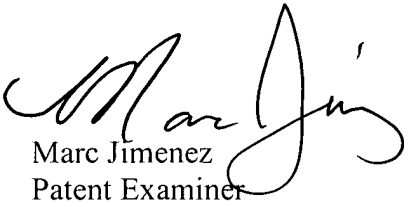
Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 273-4530. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marc Jimenez
Patent Examiner
AU 3726

MJ

November 26, 2004